

withdrawn from consideration pursuant to the election made by Applicants in the Response To Restriction Requirement dated November 4, 1999. Applicants note with appreciation the allowance of claim 19 and the indication that claims 5-10, 15-18, 33, 34, and 71 include allowable subject matter.

Claims 1-4, 11-14, 24-32, 35-38, 70, and 72-75 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,967,986 to Cimochoowski et al. ("Cimochoowski"). In the previous communication from Applicants, claim 1 was amended to recite that the sensor support includes a surface for receiving a sensor. Applicants argued that because Cimochoowski does not show such a sensor support, Cimochoowski does not anticipate claim 1. In this latest Office Action, the Examiner finds this reasoning unpersuasive, yet in allowing claim 19, which contains similar language to that of claim 1, the Examiner has set up an apparent contradiction in his own reasoning. In the previous Amendment, Applicants presented the following argument in support of the patentability of claim 19:

Although containing limitations that are worded differently than those in claim 1, claim 19 also is not anticipated by Cimochoowski for much the same reasons given above in connection with claim 1. Claim 19 recites a fixation device and at least one sensor carrier coupled to the fixation device. The claim further recites that the sensor is supported by the sensor carrier. As explained above, Cimochoowski teaches stents that do not include any sensor carriers or supports, but that instead support sensors by themselves, either by having the sensors mounted thereon, or by having the sensors integrated within their respective walls. In view of this discussion, Applicants submit that Cimochoowski does not anticipate claim 19 under 35 U.S.C. § 102(e).

Amendment dated June 28, 2000, at pages 3-4). Based on this argument, which the Examiner characterized as "compelling" (Office Action of 8/14/00, at page 5), claim 19 was allowed. Since this argument specifically relies on what was said in support of claim 1 to argue for the patentability of claim 19, Applicants are at a loss to understand how the same argument can be "compelling" for one claim and not another, especially when the element at issue in this compelling argument, whether articulated as a "support" or "carrier", is common to both claims. Although claim 19 recites a sensor carrier instead of a sensor support, the basis for the distinction over the reference is the same, namely, that Cimochoowski fails to teach every limitation of these claims because it does not include an element other than a fixation device and to which a sensor is joined. If the Examiner finds this argument sufficient to warrant the

allowance of claim 19, does it not follow that claim 1 should be allowed as well? By specifically citing Applicants' argument as the basis for the allowance of claim 19, the Examiner has accepted the fundamental distinction made in this argument, namely, that "Cimochowski teaches stents that do not include any sensor carriers or supports, but that instead support sensors by themselves, either by having the sensors mounted thereon, or by having the sensors integrated within their respective walls". Amendment dated June 28, 2000 (emphasis added). If the Examiner accepts this assertion that the reference shows no sensor carriers or supports, would it not be reasonable to expect claim 1, which does recite such a sensor support, to be allowed along with claim 19? Based on this discussion, Applicants submit that claim 1 is not anticipated by Cimochowski.

As for claims 2-4 and 11-14, Applicants submit that these claims are patentable for at least the same reasons given in support of the patentability of claim 1.

Independent claims 24 and 25 are method claims that recite the step of placing a sensor onto or into a sensor support coupled to a fixation device. Since Cimochowski does not teach or suggest a sensor support as recited in the claims, it necessarily follows that Cimochowski also does not teach or suggest these steps recited in claims 24 and 25. Accordingly, for these reasons, Applicants submit that claims 24 and 25 are not anticipated by Cimochowski.

As for claims 26-31 and 35-37, Applicants submit that these claims are patentable for at least the same reasons given in support of the patentability of claim 24.

As for claim 32, Applicants submit that this claim is patentable for at least the same reasons given in support of the patentability of claim 25.

As for claim 38, Applicants asserted in the last communication from them that Cimochowski does not show a sensor that is coupled to the bodily lumen itself. The Examiner contradicts this assertion but again has not cited any portion of this reference that supports his assertion that the reference "discloses the use of hooks or a balloon to couple the device to the vessel." Office Action of 8/14/00 at page 3. For the sake of accuracy, Applicants point out that the claim recites the step of coupling a sensor, and not just any device, to the lumen. Every time Cimochowski mentions the use of hooks, the hooks are described as coupling something other than a sensor to a lumen. For instance, at column 2, lines 63-65, Cimochowski states that "[s]ometimes, hooks are provided on the stent to ensure that the graft remains in the desired position within the vessel." Nothing in this description mentions or even implies coupling a sensor to a lumen. Similarly, at column 25, lines 36-40,

Cimochowski mentions that "[t]he stent retains the graft in position. Some stents...include metal hooks at one or both ends to firmly attach the graft to the vessel wall." Again, no mention of sensors being secured via such hooks to the lumen is made. Therefore, because Cimochowski does not show the coupling of a sensor to a bodily lumen, Applicants respectfully request allowance of this claim.

As for claims 70 and 72-75, Applicants submit that these claims are allowable for at least the same reasons given in support of the patentability of claim 1.

Claims 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cimochowski. Applicants submit that these claims are patentable for at least the same reasons given in support of the patentability of claim 38.

Applicants have added new claims 76-78. Claim 76 recites that the sensor support has a shape that is unaffected by a joining to the sensor. Claim 77 recites that the sensor support has a predefined and constant shape. Claim 78 recites that the sensor support is formed of a non-fluid material. Support for these new claims is found at least at Figures 2A, 2B, 3A, 3B, and 4, and at page 8 of the specification. The element of Cimochowski that the Examiner believes meets the sensor support recited in claim 1, namely solder 228, meets none of the limitations in these new claims. Accordingly, Applicants submit that none of new claims 76-78 is either taught or suggested by Cimochowski.

The present invention is new, non-obvious, and useful. Reconsideration and allowance of the claims are respectfully requested.

Respectfully Submitted,
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